

Applic. No. 10/722,023
Amdt. dated August 18, 2004
Reply to Office action of May 19, 2004

Remarks/Arguments:

Reconsideration of the application is requested.

Claims 1-23 remain in the application. Claim 23 has been amended. Claim 24 has been cancelled.

In item 2 on page 2 of the Office action, claim 23 has been rejected as being fully anticipated by Gatta (U.S. Patent No. 5,394,835) under 35 U.S.C. § 102. Claim 23 has been amended to include the subject matter of claim 24. Since claim 24 was not rejected in item 2 of the Office action, the rejection over Gatta under 35 U.S.C. § 102 has been overcome. Applicant will discuss the non-obviousness of claim 23 below, with respect to item 11 of the Office action, rejecting claim 24 as being obvious over Gatta.

In item 4 on page 2 of the Office action, claims 1, 8, 9, and 18-22 have been rejected as being obvious over Schwede (U.S. Patent No. 6,209,490 B1) in view of Gatta (U.S. Patent No. 5,394,835) under 35 U.S.C. § 103.

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and

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the claims have, therefore, not been amended to overcome the references.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claims 1 and 21 call for, *inter alia*:

a feeding compartment being separate from the sanitary compartment.

The Schwede reference discloses a living quarters container for cats or ferrets. The container includes an upper compartment (18) having plexiglass doors (32) for providing small animal access to the upper compartment (18) and a lower compartment (20). The upper compartment (18) and the lower compartment (20) are divided by a horizontal partition (14). The lower compartment (20) is divided by a vertical partition (24) into a waste disposal section (30) having a door (36) and an enclosed storage compartment (28), which is accessible only by opening door (34). A partial horizontal partition (26) cooperates with the partial vertical partition (24) to enclose storage compartment (28). Schwede discloses that the partial horizontal partition (26), also serves as a feeding and watering table. Schwede discloses that "this area is elevated

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above waste disposal section (30), from which it is sufficiently separated that the animals fastidious nature is not offended when eating" (column 3, lines 53-58). Schwede discloses that the door (34) also provides access for replenishment of food and water. Schwede discloses that "having smaller, separate doors 34 and 36 that do not open into the main living area of upper compartment 18, makes it easier to take care of feeding, watering and servicing litter box 48, without concern over letting the animal slip out" (column 3, lines 46-49).

Applicant respectfully disagrees with the Examiner's comments in item 4 on page 2 of the Office action, that the Schwede discloses "a feeding compartment 18 being separated from the sanitary compartment". Schwede explicitly discloses that the feeding and watering area is disposed on the partial horizontal partition section (26), which is disposed above the waste disposal section (30). Schwede explicitly discloses that partial horizontal partition (26) is in the lower compartment (20) and not in the upper compartment (18). Therefore, the upper compartment 18 is not a feeding compartment as suggested by the Examiner. Furthermore, while the watering and feeding area of Schwede is separated (disposed elevated) from the waste disposal area (30), it is not a separate compartment. This is contrary to the invention

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of the instant application as claimed, in which a feeding compartment is separate from the sanitary compartment.

It is a requirement for a *prima facie* case of obviousness, that the prior art references must teach or suggest all the claim limitations.

The references do not show or suggest a feeding compartment being separate from the sanitary compartment, as recited in claims 1 and 21 of the instant application.

The Schwede reference discloses an upper compartment (18) (pet living area), a lower compartment (20), which includes an enclosed storage compartment (28) and a feeding and watering area disposed above a waste disposal section (30) in the same lower compartment (20). The Schwede reference does not disclose a feeding compartment separate from a sanitary compartment. This is contrary to the invention of the instant application as claimed, in which a feeding compartment is separate from the sanitary compartment.

The Gatta reference discloses a pet litter housing and is not concerned with the feeding or watering of an animal. Accordingly, the Gatta reference does not disclose a feeding compartment separate from a sanitary compartment. This is

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contrary to the invention of the instant application as claimed, in which a feeding compartment is separate from the sanitary compartment.

The references applied by the Examiner do not teach or suggest all the claim limitations. Therefore, it is believed that the Examiner has not produced a *prima facie* case of obviousness.

Furthermore, even though the references cited by the Examiner do not teach or suggest all the claim limitations, applicant comments as follows with regard to the rejection over Schwede in view of Gatta. One way to overcome an obviousness rejection is by applicant's discovery of the problem. The specification of the instant application explicitly discloses that the prior art does not disclose a pet furniture which includes a sanitary compartment for a litter box, litter container for unused litter, a separate storage compartment for food and supplies, along with a separate feeding compartment that is separated from the litter box for sanitary purposes (page 2, line 20 to page 3, line 2). Since applicant discovered the problem and, accordingly, the solution to the problem, claims 1 and 21 are not obvious over Schwede in view of Gatta.

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Since claims 1 and 21 are believed to be allowable, dependent claims 8, 9, 18-20, and 22 are believed to be allowable as well.

In item 5 on page 4 of the Office action, claims 2-5 have been rejected as being obvious over Schwede (U.S. Patent No. 6,209,490 B1) in view of Gatta (U.S. Patent No. 5,394,835) and further in view of Richey et al. (U.S. Patent No. 5,749,317) (hereinafter "Richey") under 35 U.S.C. § 103. Richey does not make up for the deficiencies of Schwede and Gatta. Since claim 1 is believed to be allowable, dependent claims 2-5 are believed to be allowable as well.

In item 6 on page 5 of the Office action, claims 6-7 have been rejected as being obvious over Schwede (U.S. Patent No. 6,209,490 B1) in view of Gatta (U.S. Patent No. 5,394,835) and further in view of Wellington et al. (U.S. Patent No. 5,577,464) (hereinafter "Wellington") under 35 U.S.C. § 103. Wellington does not make up for the deficiencies of Schwede and Gatta. Since claim 1 is believed to be allowable, dependent claims 6-7 are believed to be allowable as well.

In item 7 on page 5 of the Office action, claims 10-12 have been rejected as being obvious over Schwede (U.S. Patent No. 6,209,490 B1) in view of Gatta (U.S. Patent No. 5,394,835) and

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further in view of Breeden (U.S. Patent No. 3,618,568) under 35 U.S.C. § 103. Breeden does not make up for the deficiencies of Schwede and Gatta. Since claim 1 is believed to be allowable, dependent claims 10-12 are believed to be allowable as well.

In item 8 on page 6 of the Office action, claims 13 and 14 have been rejected as being obvious over Schwede (U.S. Patent No. 6,209,490 B1) in view of Gatta (U.S. Patent No. 5,394,835) and further in view of Breeden (U.S. Patent No. 3,618,568) and further in view of Tripp (U.S. Patent No. 6,397,778) in view of Chavallo Jr. (U.S. Patent No. 5,465,682) under 35 U.S.C. § 103. Neither Tripp nor Chavallo Jr. makes up for the deficiencies of Schwede, Breeden, and Gatta. Since claim 1 is believed to be allowable, dependent claims 13 and 14 are believed to be allowable as well.

In item 9 on page 6 of the Office action, claim 15 has been rejected as being obvious over Schwede (U.S. Patent No. 6,209,490 B1) in view of Gatta (U.S. Patent No. 5,394,835) and further in view of Breeden (U.S. Patent No. 3,618,568) and further in view of Tripp (U.S. Patent No. 6,397,778) in view of Chavallo Jr. (U.S. Patent No. 5,465,682) and further in view of Ciapparelli (GB 2 227 401 A) under 35 U.S.C. § 103. Ciapparelli does not make up for the deficiencies of Schwede,

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Breeden, Tripp, Chavallo Jr., and Gatta. Since claim 1 is believed to be allowable, dependent claim 15 is believed to be allowable as well.

In item 10 on page 7 of the Office action, claims 16 and 17 have been rejected as being obvious over Schwede (U.S. Patent No. 6,209,490 B1) in view of Gatta (U.S. Patent No. 5,394,835) and further in view of Uhrick (U.S. Patent No. 4,683,839) under 35 U.S.C. § 103. Uhrick does not make up for the deficiencies of Schwede and Gatta. Since claim 1 is believed to be allowable, dependent claims 16-17 are believed to be allowable as well.

Even though the dependent claims that have been rejected in items 5-10 of the Office action, as noted above, are believed to be allowable, the following remarks are made.

A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614,1617 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be

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understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." *Id.* (quoting *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983) (emphasis added by applicant)).

Most if not all inventions arise from a combination of old elements. See *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See *id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See *id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 163.5, 1637 (Fed. Cir. 1998); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the

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problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein). Whether the examiner relies on an express or an implicit showing, the examiner must provide particular findings related thereto. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence." Id. When an examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed on the record. See In re Lee, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002).

Upon evaluation of the examiner's comments in items 5-10 of the Office action, it is respectfully believed that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims rejected in items 5-10 of the Office action.

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In item 11 on page 8 of the Office action, claim 24 has been rejected as being obvious over Gatta (U.S. Patent No. 5,394,835) under 35 U.S.C. § 103. As noted above, claim 23 has been amended to include the subject matter of claim 24. Therefore, the following comments will pertain to claim 23.

Claim 23 calls for *inter alia*:

a litter container having a slanted bottom region, the litter container storing clean unused litter to be dispensed into the litter box, and a litter dispenser being a hose attached to the litter container at the slanted bottom region.

Applicants respectfully disagree with the Examiner's comments in item 11 on page 8 of the Office action, that "it would have been an obvious substitution of functional equivalent to substitute the dispenser tray of Gatta with a hose, since both types of dispenser mechanism would allow clean litter to be dispensed into the litter box". It is respectfully believed that the Examiner is overlooking that such a substitution would destroy the intended function of Gatta.

More specifically, Gatta discloses that the transfer of litter from the different hoppers can be actuated by sliding plates

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which are moveable from the outside of the structure. Gatta discloses that doors control dust when the litter is being dispensed (column 2, lines 52-54). Replacing the sliding plates with a hose as suggested by the Examiner would force the doors (32) to be opened during the transfer of litter to allow at user to be able to dispense the litter. The open doors (32) would allow dust to escape from the structure, which in turn destroys an intended function of the Gatta reference.

Therefore, a person of ordinary skill in the art would not use a hose to dispense litter in Gatta, as suggested by the Examiner, as this would allow dust to escape from the doors (32) of Gatta, thereby destroying an intended function of Gatta. Since the modification of substituting a hose for the sliding plate, as suggested by the Examiner would destroy its intended function of the sliding plate, there is no motivation to combine the references. Therefore, claim 23 is not obvious over Gatta.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claims 1, 21, or 23. Claims 1, 21, and 23 are, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately

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dependent on claims 1 or 22, they are believed to be
patentable as well.


In view of the foregoing, reconsideration and allowance of
claims 1-23 are solicited.

In the event the Examiner should still find any of the claims
to be unpatentable, counsel respectfully requests a telephone
call so that, if possible, patentable language can be worked
out.

If an extension of time for this paper is required, petition
for extension is herewith made.

Please charge any other fees which might be due with respect
to Sections 1.16 and 1.17 to the Deposit Account of Lerner &
Greenberg P.A., No. 12-1099.

Respectfully submitted,


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